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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/643,448 | 08/18/2003 | Grant Stipek | 3725-901-CON | 4404 |
| 22442 | 7590 | 08/11/2004 | EXAMINER | |
| SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202 | | | VU, STEPHEN A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3636 | |

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,448

Applicant(s)

STIPEK, GRANT

Examiner

Stephen A Vu

Art Unit

3636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 34 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 36-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/18/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I on May 18, 2004 is acknowledged. The traversal is on the ground(s) that (A) the inventions must be independent or distinct as claimed and (B) there must be a serious burden on the examiner if restriction is required (MPEP 803). This is not found persuasive because for the reasons set forth below.

It appears that the applicant's arguments has not analyzed the examiner's action in the context of the established practices for requiring a provisional election of species as established in Chapter 800 of the MPEP. It is a well-established practice that a requirement to elect a single disclosed species is a holding by the examiner that the plural species, as claimed, are patentably distinct, i.e., capable of supporting separate patents. See MPEP 808.01(a) and MPEP 809.02(a). If the applicant is of a different view, then applicant need merely states on the record that the species are not patentably distinct. Neither the examiner nor the applicant needs to present any reasoning. Of course, it should be noted that the species that are not patentably distinct for restriction purposes are also not patentably distinct (i.e., obvious in view of one another) for rejection purposes. Applicant's response implies that the various identified species are not considered to be patentably distinct. If such is the case, then applicant must clearly admit this on the record or point to evidence already of record.

With respect to applicant's first argument, it is noted that the examiner fully complied with required and well-established procedures pertaining to the making of a

provisional election requirement. The procedures are clearly and explicitly outlined in MPEP 809.02(a). Further, MPEP 817 clearly states that “(t)he statement in MPEP 809.02 - 809.02(d) is adequate indication of the form of letter when an election is required.” Further, MPEP 806.04(h) clearly states that the examiner is to group together species that are clearly unpatentable over each other. Thus, it is inherently quite evident that species not grouped together are considered to be patentably distinct from the other separately listed species.

Applicant’s allegation that the search would be done in the same classifications and the search and examination would not be a burden on the examiner. Please note that it is extremely burdensome to carry out a search for all the features of the different species and an examination, including consideration of and response to arguments, for all of the specific features of each of the multiple patentably distinct species in the same application.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 404, 302a, 302b, 302c, 302d, 704, 88b, 88c, 88d, 88e, 88f, and 88g. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the

application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for providing therapeutic service selected from the group consisting of massage, pneumatic variable body support and heating as mentioned in claim 31 and the means for controlling the relative movement as mentioned in claim 33 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.

- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Please note that the specification lacks the proper headings for their respective subject matters, i.e. BRIEF SUMMARY OF THE INVENTION, BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S), DETAILED DESCRIPTION OF THE INVENTION, etc.

Claim Rejections - 35 USC § 112

Claims 1,5,11-12,20-29,31-33,36-37,43-51,53, and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 57 recite the limitation "the larger part" in line 6. There is insufficient antecedent basis for these limitations in the claims.

Regarding claims 5 and 11, the word "means" is preceded by the word(s) "provide" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claims 20-22,24,26,29, 31-32,36-37,43-45,48,50, and 53 recite the limitation "the frame" in line 2. It is unclear if "the frame" refers to the "internal frame" or the "weight-bearing frame".

In claim 23, the phrase "one or more molded components define a first depth orientated to provide strength for assuming compressive load forces greater than the strength obtained from at least some other orientation of depth" appears to constitute an unbased comparison since aspects of the positively claimed members (i.e. molded components) are being claimed in relation to a non-positively claimed item (i.e. some other orientation of depth that has not been clearly identified).

Claim 24 recites the limitation "the shell-structure molded component" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

With claim 33, the phrase "means for controlling the relative movement" appears to be unclear and indefinite, because it is uncertain what particular structure is being moved relative to another particular structure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-23,25,29,36-46,48,50, and 53-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Thaden (#2,818,107).

Thaden (#2,818,107) shows an internal frame (1) comprising a weight-bearing frame (3) having a main load area and defining at least one span across a part of the main loading area. A larger part of the weight bearing frame is at least one molded component (see col. 1, lines 15-16). The main loading area is substantially a lattice form and defined by at least one molded component positioned substantially around all sides of a recessed area (10) with the main load area of the weight bearing frame.

With claim 2, the larger part is capable of supporting the weight of one or more users.

With claims 3 and 7, the one molded component is capable of supporting a user is substantially scaled.

With claims 4,8, and 21, the one molded component is capable of supporting a user is substantially contoured.

With claims 5,9,10, it is best interpreted that one molded components is capable of supporting a user is structurally integrated.

With claim 6, the one molded component is capable of supporting a user.

With claims 11 and 13, the one molded component is substantial torsional strength.

With claims 12 and 14, the one molded component is shell-structure.

With claim 15, it is considered that the lattice form is plural.

With claim 16, it is considered that the one molded component is an efficient structure.

With claim 17, the one molded component is considered to be an optimized structure.

With claim 18, at least a portion of the one molded component is substantially flexible.

With claim 19, at least a portion of the one molded component is a closed shell construction shell-structure.

With claim 20, at least a portion of the frame is an openwork.

With claim 21, the molded components are capable of supporting the weight of one or more users.

With claim 22, bearing portions of the frame are molded components.

With claim 23, it is best interpreted that the one molded component has a first depth.

With claim 25, the one molded component is shaped to be capable of transferring loads to regions of load distribution.

With claim 29, the frame is contoured to accommodate stacking.

With claims 36-37 and 44-46, Thaden discloses in another embodiment (see Figure 6), that the use of strapping (34) coupled to the internal frame for stress distribution to the back of the chair.

With claims 38-42, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, these limitations have not been give patentable weight.

With claim 43, the frame is at least partially upholstered with a seat liner (13) (see col. 2, lines 47-70).

With claims 48 and 50, a first material (13) with padding properties is coupled to the frame.

With claim 53, the frame is capable of supporting than one user.

With claim 54, it is interrupted that the lattice form defines a skeletal framework.

With claims 55 and 56, it is interpreted that the lattice form defines a lattice structure that is a space-frame.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 26-28,30, and 32-33, 47,49, and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thaden (#2,818,107).

With claims 26-28 and 32, Thaden discloses the claimed invention except for the frame to be constructed of separable sections. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the frame as separable sections, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. The separable sections when assembled together as one frame would be capable of stacking two frames together.

With claim 30, it would have been an obvious matter of design choice to have a portion of the frame to be customized fit to a user.

With claim 33, it is best understood that Thaden has means (2) for controlling relative movement of a user's body along the span.

With claim 47, Thaden discloses the suspension material (34) to be a rope or tape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the suspension material with fabric, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

With claims 49 and 51, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thaden (#2,818,107) in view of Bentley (#4,190,286).

Thaden discloses the claimed invention except for the frame to have a means for providing a therapeutic service for massage. Bentley teaches a portable body support assembly (10) to provide massaging support to the back of the user. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ Bentley's portable body support assembly (10) for use with the internal frame of Thaden's invention, in order to provide massaging and lumbar support to the back of the user.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1-23, 25-33, and 36-57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-20,27-34,37,39,42-49,57-59,62-65, and 69-72 of U. S. Patent No. 6,702,391. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-20,27-34,37,39,42-49,57-59,62-65, and 69-72 of U. S. Patent No.

6,702,391 disclose a frame comprising a weight-bearing frame having a main load area and molded components positioned substantially around all sides of a recessed area.

Allowable Subject Matter

Claim 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baxter et al, Leib, Caruso, and Ratalahti are cited as showing similar types of chair.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen A Vu whose telephone number is 703-308-1378. The examiner can normally be reached on M-F from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M Cuomo can be reached on 703-308-0827. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephen Vu
August 8, 2004